

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

MAR 26 2003

Ex parte OLIVIER LEGENDRE
and CHRISTOPHER NEDEZ

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2002-0214
Application 08/914,244

ON BRIEF

Before WARREN, DELMENDO and POTEATE, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal, Opinion and Remand

This appeal under 35 U.S.C. § 134 involves the following grounds of rejection: claims 1 through 3, 7 and 11 through 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Goodboy; claims 4 through 6, 8, 9 22 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Goodboy in view of Dupin et al.; and claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Goodboy in view of Flytzani-Stephanopoulos et al.^{1,2}

With respect to the ground of rejection under § 102(b), we agree with appellants (brief,

¹ These are all of the claims in the application. See, e.g., the amendments of October 10, 1996 in parent application 08/501,872 (Paper No. 7) and of March 16, 1999 in the present application (Paper No. 24).

² Answer, pages 3-5.

pages 12 through 15, first full paragraph) that the examiner has failed to make out a *prima facie* case of anticipation by merely pointing to the fact that the claimed ranges for the effective amount of Na₂O (e.g., appealed claims 1 through 3 and 11) and for specific surface area (e.g., appealed claim 16) fall *within* the ranges for the same variables in Goodboy. We know of no authority which is contrary to the representative authority cited by appellants (brief, pages 12-13), that is, there is no authority which holds that a broad prior art range that encompasses a claimed range anticipates the claimed range as opposed to rendering such claimed subject matter obvious. *Cf. also In re Rainer*, 377 F.2d 1006, 1010-11, 153 USPQ 802, 805-06 (CCPA 1967) (“Criticality must be established before unobviousness can be predicted on the selection of a temperature within the range disclosed by the reference.”). Indeed, in this case, we find no teaching in Goodboy which clearly and unequivocally discloses the ranges of the rejected claims *per se* or directs those of skill in the art to the claimed ranges *per se* without any need for judicious picking and choosing. *See generally, In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972) (“[F]or the instant rejection under 35 U.S.C. 102(e) to have been proper, the . . . reference must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference. Such picking and choosing may be entirely proper in the making of a 103, obviousness rejection, where the applicant must be afforded an opportunity to rebut with objective evidence any inference of obviousness which may arise from the *similarity* of the subject matter which he claims to the prior art, but it has no place in the making of a 102, anticipation rejection.”).

Accordingly, on the record now before us, we reverse the ground of rejection of appealed claims 1 through 3, 7 and 11 through 21 under § 102(b) as being anticipated by Goodboy.

The examiner’s decision is reversed with respect to appealed claims 1 through 3, 7 and 11 through 21.

REMAND TO THE EXAMINER

The remaining two grounds of rejection under § 103(a) based on Goodboy as the primary reference involve appealed claims 4 through 6, 8 through 10, 22 and 23, which are all of the remaining appealed claims. It is apparent that the examiner states these grounds of rejection on

the basis that Goodboy is considered to anticipate subject matter encompassed by appealed claim 1 on which the appealed claims rejected under § 103(a) depend.³ Because we reversed the ground of rejection under § 102(b), the examiner thus has not provided on this record any reason(s) why Goodboy provides the factual foundation for an obviousness rejection of appealed claim 1, of appealed claims dependent thereon and of the other independent appealed claims and appealed claims dependent thereon which were rejected on the same reference under § 102(b). *See In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973) (a reference that does not anticipate the claimed invention under § 102(b) can still be applied thereto “as evidence of obviousness under § 103 for all it fairly suggests to one of ordinary skill in the art”).

Therefore, in the absence of the examiner’s consideration of the subject matter of appealed claims 1 through 3, 7 and 11 through 21 over Goodboy under § 103(a), the issues in this case with respect to this statutory provision are not ripe for consideration on appeal.

We decline to exercise our authority under 37 CFR § 1.196(b) and enter on the record a new ground of rejection of appealed claims 1 through 3, 7 and 11 through 21 under § 103(a) as unpatentable over Goodboy, leaving it to the examiner to apply Goodboy to appealed claims 1 through 3, 7 and 11 through 21 under § 103(a), to reconsider the two grounds of rejection now of record of the remaining appealed claims under § 103(a) based on Goodboy in doing so, and to consider whether any other prior art should be applied in this respect.

Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure to reopen prosecution with respect to all of the claims on appeal on the basis indicated above, with a view toward placing this application in condition for decision on appeal with respect to issues under § 103(a).⁴

Furthermore, when this application is otherwise in condition for allowance, the examiner

³ Answer, pages 4-5.

⁴ The failure to include an independent claim and claims dependent thereon in a ground of rejection under § 103(a) which applies thereto will result in reopening of prosecution, either by the Board under 37 CFR § 1.196(b) or by the examiner on remand, when the rejection of such claims under a section of § 102 is reversed and the claims are then rejected in one or more new grounds of rejection on the same or modified grounds under § 103(a) already of record, thus unduly prolonging the pendency of the application.

should consider whether appellants have improperly incorporated "essential material" for the preparation of the claimed activated alumina catalysts in the specification by reference to French patent literature (*e.g.*, page 6, lines 22-25; *cf.* Goodboy, *e.g.*, col. 5, lines 13-40). *See* MPEP § 608.01(p) (8th ed., August 2001; 600-79 – 600-80).

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

This application, by virtue of its "special" status, requires immediate action. *See* MPEP § 708.01(d) (8th ed., August 2001; 700-105). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal in this case. *See, e.g.*, MPEP§ 1211 (8th ed., August 2001; 1200-30).

Reversed-In-Part

Remanded


CHARLES F. WARREN)
Administrative Patent Judge)
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ROMULO H. DELMENDO)
Administrative Patent Judge)
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LINDA R. POTEATE)
Administrative Patent Judge)
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